

R E M A R K S

Claims **1 - 50 and 52** are pending.

Claims **1, 16, 19, 31, 34, 46, 49, 50 and 52** are independent.

Section 103(a) Rejections

Claims **1 - 12, 14 - 50 and 52** are rejected as being unpatentable over a combination of Picioccio (U.S. Patent No. 5,997,236) and Rossides (U.S. Patent No. 5,269,521).

Claim **13** has been rejected over a combination of Picioccio and Roberts (U.S. Patent No. 5,772,510).

Applicants traverse the Examiner's Section 103(a) rejections. There has been no *prima facie* showing that any claim would have been obvious.

I. Subject Matter Without Support in the Record is not Substantial Evidence

As discussed below, the Examiner has based several rejections on subject matter which is alleged to be well known. No evidence of any kind has been provided for these allegations. Appellants have already disputed various assertions regarding what is 'well known' but unsupported by the record.

Appellants' First Response mailed April 17, 2001, pages 9 - 10. Appellants' Second Response mailed January 28, 2002, pages 3 - 4.

Appellants note that the scope of the matter of which the Examiner could take Official Notice is strictly limited to the substantial evidence in the record for such matter. The references of record clearly do not support the Examiner's broad assertions as to what was well known.

Accordingly, the Examiner's sweeping assertions which are not supported by the references of record lack substantial evidence, and therefore cannot be used as prior art to the present application. Only the content of the references of record which are prior art to the present application may so used. "[D]eficiencies of the cited references cannot be remedied by the Board's general conclusions about what is 'basic knowledge' or 'common sense.'" In re Zurko, 258 F.3d 1379, 1385, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001); In re Lee, 277 F.3d 1338, 1344, 61 USPQ2d 1430, 1434 (Fed. Cir. 2002).

II. Limitations of Independent Claims Not Present

Every independent claim (independent claims **1, 16, 19, 31, 34, 46, 49, 50 and 52**), and thus all pending claims, includes the following feature:

- *outputting an offer of a product* which is
- *selected from among the plurality of products based on a monetary value and minimum acceptable price data*

In different claims, the *monetary value* of this feature is either:

- a monetary value *available for purchasing a product* (independent claims **1, 19, 34, 49**)

OR

- the *difference between* a first monetary value received from a consumer and *the price of the first product* (independent claims **16, 31, 46, 50, 52**)

The Examiner has not shown that the references, alone or in combination, suggest *outputting an offer of a product* which is *selected from among the plurality of products based on the monetary value and the minimum acceptable price data*.

Proposed Factual Findings

The Examiner admits that Picioccio does not disclose that there is *minimum acceptable price data* for products. Third Office Action, page 3, paragraphs (a) and (c).

The Examiner asserts that Rossides "discloses normal price data or minimum acceptable price data for each of a plurality of products. I [sic] abstract (expected price, price offered), col 8, L 5-22, 65-68; col 9, L 34-38; col 15, L 9-16; col 16, L 15-53." Office Action, page 3, second paragraph.

On the contrary, Rossides suggests neither normal price data or minimum acceptable price data for each of a plurality of products.

However, the cited portions of Rossides disclose a gambling system in which one may make a bet and thus pay for a chance of winning a greater number of units of a product, rather than paying for the certainty of a product. For example, the first portion of Rossides the Examiner cites (col. 8, lines 5 - 22) disclose that rather than purchasing 50 pens for \$100 (a unit cost of \$2 per pen), one could instead make a bet in which the store wins 500 pens with a 1 / 5 chance of winning at a cost of \$100. Since there is a 1 / 5 chance of winning, the expected number of pens received in that bet is 100 pens (500 pens x 1 / 5). Thus, the unit cost per pen in this bet is only \$1 per pen (\$100 / 100 expected pens).

The remaining portions of Rossides likewise do not disclose or suggest that there is *minimum acceptable price data* for products.

Since the references of record suggest even that there is *minimum acceptable price data* for products, the references of record clearly cannot suggest the limitation (present in all claims) of:

- *outputting an offer of a product* which is
- *selected from among the plurality of products based on a monetary value and minimum acceptable price data*

Consequently, a prima facie case of unpatentability has not been made.

III. No Motivation to Combine or Modify Picioccio and Rossides

The Examiner offers the following motivation to combine Picioccio and Rossides:

"it would have been obvious to one of ordinary skill in the art at the time of applicant's [sic] invention to use these features for the advantage of increasing sales and moving inventory"

See, Office Action, page 3, et seq.

The proposed "motivation" is generally an allegation that the modification would have been beneficial. However, a motivation to modify only exists where the prior art teaches such a benefit. There must be substantial evidence that the prior art would have provided such a motivation. The record does not support the proposed motivation.

No evidence has been provided that the prior art would in any way recognize the desirability of the proposed combination. Accordingly, there has been no prima facie showing of obviousness of any claim.

IV. No Prima Facie Showing For Independent Claim 16

On pages 7 - 8 of the Office Action, the Examiner asserts (without any factual support in the record) that:

"crediting 'change' or refunds to the next payment is old and well known in the credit and debt payment (as in the income tax refund option to credit the refund to the next year [sic] tax liability) art."

With respect to the factual assertion, whether or not the assertion would have been true in one field, without a reference that documents this assertion the record lacks any showing of (1) whether this assertion is analogous art, and (2) how this assertion would have been understood and interpreted by one of ordinary skill in the relevant art.

In addition, the purported motivation to combine this unsupported assertion with Picioccio is:

"It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use refunds for complementary purchases and thus to maximize sales."

Office Action, page 8.

Since this proposed 'motivation' is not supported by any reference of record, the record does not support the combination, and thus no prima facie showing of obviousness has been made..

V. No Prima Facie Showing of Obviousness of Dependent Claims

Since the record fails to show the obviousness of any independent claim, the record cannot show that any dependent claim is obvious. Moreover, even if the record did show the obviousness of any independent claim, the rejection of several dependent claims lacks a proper evidentiary basis for a prima facie showing of obviousness.

Claims 10 - 11, 24, 25, 26

Since, as argued above, Rossides (as well as the other references of record) does not in any way suggest *minimum acceptable price data*, Rossides (as well as the other references of record) cannot suggest the claimed limitations of:

receiving minimum acceptable price data from an operator

(claim 10)

determining whether the monetary value is at least as great as the lowest minimum acceptable price, and wherein the step of offering is performed only upon determining that the monetary value is at least as great as the lowest minimum acceptable price

(claim 11)

determine minimum acceptable price data based on sales activity

(claim 24)

receive minimum acceptable price data from an operator

(claim 25)

determine whether the monetary value is at least as great as the lowest minimum acceptable price, and
to offer the product performed only upon determining that the monetary value is at least as great as the lowest minimum acceptable price
(claim 26)

Accordingly, there has been no prima facie showing that these dependent claims would have been obvious.

Claim 12, 27

Claim 12 recites the following limitation:

"the step of determining [whether the consumer accepts the offer] includes providing a predetermined amount of time during which the consumer may refuse to accept the product"

On page 6 of the Office Action, the Examiner admits that "Picioccio does not explicitly disclose the time delay for optional refusal."

However, the Examiner then makes the following unsupported factual assertion:

"Official notice is taken that it is old and well known in the vending art for a customer to refuse to select and push the return change button.

From this unsupported finding, the Examiner then makes another unsupported factual finding:

"It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use a microcontroller or PLC to create a time delay feature for possible rejection of the product to allow more choices for the customer."

Since the record does not provide any support for these factual premises, there has been no prima facie showing that dependent claim **12** would have been obvious.

The rejection of claim **27** is predicated on the same reasoning, and thus there has been no prima facie showing that dependent claim **27** would have been obvious.

Claim 13

Claim 13 recites the following limitation:

"the database further includes expiration data for each of the plurality of products and wherein the step of selecting [a product from among the plurality of products based on the monetary value and the minimum acceptable price data] is further based on the expiration data."

The Examiner makes the following factual assertion:

" Neither Picioccio nor Rossides explicitly disclose expiration data for each of the plurality of products and the step of selecting is further based on the expiration data. However, Roberts discloses expiration data for each of the plurality of products and the step of selecting is further based on the expiration data. I [sic] fig 2A(drawing at 7:00; fig 88(7:30 PM).

Office Action, page 22.

Whether or not Roberts could be interpreted as suggesting "expiration data for each of the plurality of products", Roberts does not disclose or suggest doing anything based on expiration data, much less:

"selecting [a product from among the plurality of products based on the monetary value and the minimum acceptable price data] is further based on the expiration data"

Moreover, Roberts is directed to a lottery ticket system, and this is not analogous art.

The Examiner further makes another unsupported factual finding:

"It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use this feature for the advantage of moving old inventory and thus maintaining customer satisfaction."

Office Action, page 22.

Since this proposed 'motivation' is not supported by any reference of record, the record does not support the combination, and thus no prima facie showing of obviousness has been made..

Claim 17

Claim 17 recites the following limitation:

*"calculating an additional amount, the additional amount being the difference between the second monetary value and the minimum acceptable price of the second product; and
prompting the consumer to supply funds at least equal to the additional amount."*

The Examiner makes the following unsupported factual assertion on pages 8 - 9 of the Office Action:

"Rossides discloses upsell [sic] or the handling of change or refund [sic] from the vending machine. I [sic] col 8, L 5-22, L 65-69; col 11, L 19-24."

In fact, the cited portions of Rossides have nothing at all to do with either refunds or change or vending machines, much less with "upsell or the handling of change or refund from the vending machine"

Moreover, the Examiner also makes another unsupported factual finding:

"It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use refunds for complementary purchases and thus to maximize sales."

There is no indication in any reference of record to support this assertion.

Since the record does not provide any support for these factual premises, there has been no prima facie showing that these dependent claims would have been obvious.

Claim 18

Claim 18 recites the following limitation:

"the database further includes complementary product data for each of the plurality of products and wherein the step of selecting is further based on the first product and the complementary product data for the first product"

The Examiner makes the following unsupported factual assertion on page 9 of the Office Action:

"official notice is taken that complementary products are old and well known in the food retail industry."

With respect to the factual assertion, whether or not the assertion would have been true in one field, without a reference that documents this assertion the record lacks any showing of (1) whether this assertion is analogous art, and (2)

how this assertion would have been understood and interpreted by one of ordinary skill in the relevant art.

In addition, the purported motivation to combine this unsupported assertion with Picioccio is:

"It would have been obvious to one of ordinary skill in the art at the time of applicant's invention to use complementary data for marketing feedback to determine the degree of correlation among various complementary pairs to increase sales."

Office Action, page 9.

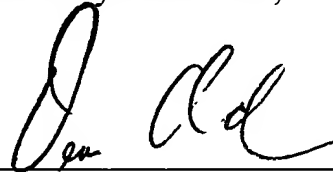
Since this proposed 'motivation' is not supported by any reference of record, the record does not support the combination, and thus no prima facie showing of obviousness has been made.

Conclusion

For the foregoing reasons it is submitted that all of the claims are in condition for allowance and the Examiner's early re-examination and reconsideration are respectfully requested.

Alternatively, if there remains any question regarding the present application or any of the cited references, or if the Examiner has any further suggestions for expediting allowance of the present application, the Examiner is cordially requested to contact Dean Alderucci at telephone number 203-461-7337 or via electronic mail at Alderucci@WalkerDigital.com.

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'Dean Alderucci', is written over a horizontal line.

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